

MAIL STOP INTERFERENCE
ALEXANDRIA VA 22313-1450
Tel: 703-308-9797
Fax: 703-305-0942

Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,197

OSIRIS THERAPEUTICS, INC.
(US 6,030,836),
Junior Party,

v.

CASE WESTERN RESERVE UNIVERSITY
(09/321,655)
Senior Party.

MAILED

JAN 9 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

A. Declaration of interference

An interference is declared (35 U.S.C. 135(a)) between the captioned parties. Details of the application, patent, count, and claims designated as corresponding to the count appear under headings E and F of this NOTICE.

B. Administrative patent judge assigned to administer the interference

The interference has been assigned to Administrative Patent Judge Richard Torczon. 37 CFR § 1.610.

C. Standing order

A copy of the Trial Section STANDING ORDER (Paper 2) accompanies this NOTICE. The STANDING ORDER applies to this interference.

D. Conference call to set dates

A telephone conference call to set dates for action in this interference is scheduled for **10 a.m. (Eastern) on 2 March 2004**. (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See STANDING ORDER ¶ 10.

A copy of a sample order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE. Counsel are encouraged to discuss the order by telephone prior to the telephone conference call and to reach an agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine months. Counsel should be prepared to justify any request for a shorter or longer period.

The Board is conducting a pilot program in electronic filing of interference papers. The procedure is explained in University of New Mexico v. Fordham Univ., No. 104,761 (2001) (<http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>). Counsel should be prepared to discuss participation in the pilot program.

E. The parties to this interference

Junior Party

Inventors: Mark A. Thiede of Forest Hill; Mark F. Pittenger of Severna Park; and Gabriel Mbalaviele of Columbia, all of Maryland

Patent: US 6,030,836, issued 29 February 2000
(09/327,840, filed 8 June 1999)

Title: Vitro [sic, In Vitro] maintenance of hematopoietic stem cells

§102(g) benefit: None

Assignee: Osiris Therapeutics, Inc.

Attorneys: See last page

Address: See last page

Senior Party

Inventors: Stanton L. Gerson of Pepper Pike, Ohio

Application: 09/321,655, filed 28 May 1999

Title: Hematopoietic progenitor cell gene transduction

§102(g) benefit: 60/087,284, filed 29 May 1998

Assignee: Case Western Reserve University

Attorneys: See last page

Address: See last page

F. Count and claims of the parties

Count 1

The method of 6,030,836 claim 18.

The claims of the parties are:

Osiris: 1-25

CWRU: 2-5

The claims corresponding to Count 1:

Osiris: 1-3, 8, 12, 13, and 18
CWRU: 2-5

The claims not corresponding to Count 1:

Osiris: 4-7, 9-11, 14-17, and 19-25
CWRU: None

G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See STANDING ORDER ¶ 3.5.

H. Summary of dates for taking action

Addendum 2 provides a summary of dates and times for taking action set in the STANDING ORDER.

I. Order form for requesting file copies

Addendum 3 provides an order form for requesting file copies. Use of the form will expedite the processing of your request.

J. Notice of intent to publish

In the event that this proceeding should result in a decision or order that the Board believes would be of interest to the public, the decision or order will be published without redaction unless, within sixty days of the entry date of this notice of declaration a party files as a separate paper a notice that specifically identifies information in its application that is not already publicly available that would warrant redaction.

If, after filing such notice, specifically identified information becomes publicly available (for example, through publication of a collateral application), the party shall promptly notify the Board of this change in the status of the information.

The parties are reminded that, in any case, at the end of the proceeding all of the information in the proceeding may be publicly available pursuant to 37 CFR § 1.11(e).



RICHARD TORCZON
Administrative Patent Judge

Enclosures:

- Copy of STANDING ORDER (Paper 2)
- Copy of order used for setting times for taking action in the preliminary motion phase of the interference
- Copy of order used for setting times for taking action in the priority phase of the interference

cc (via overnight carrier):

For Osiris Therapeutics, Inc.:

Elliot M. Olstein

Raymond J. Lillie

CARELLA BYRNE BAIN GILFILLAN CECCHI STEWART & OLSTEIN

6 BECKER FARM RD

ROSELAND NJ 07068

Tel: 973-994-1700

Fax: 973-994-1744

For Case Western Reserve Univ.:

Elliot M. Olstein

Raymond J. Lillie

CARELLA BYRNE BAIN GILFILLAN CECCHI STEWART & OLSTEIN

6 BECKER FARM RD

ROSELAND NJ 07068

Tel: 973-994-1700

Fax: 973-994-1744

ADDENDUM 1

Filed on behalf of: Party _____
By: Name of lead counsel
Name of backup counsel
Street address
City, State, and ZIP Code
Tel:
Fax:

Paper No. _____¹

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)

OSIRIS THERAPEUTICS, INC.
(US 6,030,836),
Junior Party,

v.

CASE WESTERN RESERVE UNIVERSITY
(09/321,655)
Senior Party.

Patent Interference No. 105,197

TITLE OF PAPER

¹ Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.

ADDENDUM 2

SUMMARY OF DATES FOR TAKING ACTION

Dates and times for taking action are set in the following paragraphs of the
STANDING ORDER:

<u>Date</u>	<u>Paragraph</u>
Identifying lead and backup counsel	¶ 4
Identifying any real party in interest	¶ 5
Requesting copies of involved and benefit applications and patents	¶ 6
Accomplishing certain discovery	¶ 7
Filing clean copy of claims	¶ 8
Filing clean copy of claims in cases with drawings or claims containing a means-plus-function limitation	¶ 9
Filing list of proposed preliminary motions	¶ 10
Filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions	¶ 13.10.2
Objecting to admissibility of evidence	¶ 14.1.1
Serving supplemental affidavits or evidence to respond to objection to admissibility of evidence	¶ 14.2
When cross-examination can take place	¶ 14.3
Taking action with respect to settlement discussions	¶ 15.2

ADDENDUM 3

FILE COPY REQUEST
Patent Interference No. 105,197

Attach a copy of section E of this NOTICE to this REQUEST. On the copy, circle each patent and application that you are requesting.

Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box because file copies are sent by commercial overnight courier).

3. Telephone, including area code: _____



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/321655	05/28/99	Gerson	640100-304

EXAMINER

Quang Nguyen

ART UNIT	PAPER NUMBER
1632	10

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.


Commissioner of Patents

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is suspended from the mailing date of this letter. Attached is the Examiner's supplemental amendment (Paper No. 8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Dave Nguyen, may be reached at (703) 305-2024, or SPE, Karen Hauda, at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Patsy Zimmerman, whose telephone number is (703) 308-0009.


DAVE T. NGUYEN
PRIMARY EXAMINER



UNITED STATES PATENT AND TRADEMARK OFFICE


DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Richard Torczon
Telephone: (703) 308-9797
Facsimile: (703) 305-0942

Applicant: Gerson
Application No.: 09/321,655
Filed: 05/28/99
For: Hematopoietic progenitor cell gene
transduction

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,197.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).


Richard Torczon
Administrative Patent Judge